REMARKS

Applicant and his attorney again wish to express their appreciation to the Examiner for the recent interview which is believed to have been most helpful in clarifying the Examiner's understanding of the invention as well as applicant's attorney's understanding of some aspects of the outstanding rejection. During the interview, applicant gave a brief summary of the background to this invention (appears in greater detail in the specification at p. line 27 - p. 9, line 15, to which reference may be had for more particulars), and provided the Examiner with small samples of a coextruded single film of the structure used in a basic embodiment of the present product (as defined, e. g. in main product claim 1), taken directly from the extrusion line and before stretching and thus having a greater thickness than would normally be the case, as well as of a final product as a whole. As was evident from the single film sample, the several layers thereof are formed into an integrated coherent unitary structure and it especially to be noted that the strands of the arrays on one side of each of films A and B is not a discrete or distinct filament but is rather spread out and, in effect, merged or blended into the underlying second surface layer interposed between the strand arrays and the main film layer.

It is also important to realized that in the invention, each of the films A and B have a molecular orientation either in one direction (uniaxially) or two directions (biaxially) with one main direction of orientation and this characteristic is now recited explicitly in main product claim 76 (paralleling the existing limitation in main process claim 101). This orientation is acquired in part by melt orientation occurring when the polymer streams are "squeezed" out of the extrusion die orifice and in part by stretching which lengthens and aligns the polymer chains and imparts a kind of "grain" to the film. Due to the orientation, the material has high tensile strength in the lengthwise (or main) direction of orientation but is susceptible to splitting or tearing in the cross-wise direction, especially when a "notch" or cut is present.

The latter produces a so-called "notch effect" whereby the tearing forces are "focused" or "concentrated" at the bottom point of the notch greatly reducing the tearing resistance (or increasing the tendency of a tear to propagate along the "grain") compared to the tearing resistance of the same film absent a "notch". As an analogy, it is common knowledge that wood having a grain when hit with an axe (forming a kind of notch) will split readily along the grain while strongly resisting splitting across the grain.

In laminates of this general type, two films of the structure just described are laminated together in such a relationship that their main directions of orientation (and thus their high strength directions) cross one another. Consequently, the tear propagation action in one film will "compete" with (or "oppose") the tear propagation action in the other film, causing the tearing forces to "fork" and thereby become weakened. All of the above is disclosed in the prior art, especially applicant's prior U. S. patent 4,039,364, of record, and its generally corresponding British patent 1,526,722, made of record in the "SECOND PRELIMINARY AMENDMENT, dated April 19, 2006, and the references identified therein. As explained in col. 5, lines 43 - 55 of the -364 patent. For the forking of the tearing forces to be achieved, it is essential that in the lamination, the lamination strength of the films be generally weak so as to allow for a localized delamination to take place in the region of the "notch point". Of course, the necessity for a weak lamination bond increases the susceptibility of the laminate to undergo delamination (or pulling apart) of the individual films thereof which obviously reduces the durability of the lamination. The Examiner was, in fact, shown a bag made according to his prior teachings that had been used by applicant to carry files and the like on travels over several years which exhibited serious delamination. Thus, as the specification sets forth at p. 4, lines 7 - 25, there is a kind of "opposition" between the need for a strong bond for durability and a weak bond for localized delamination to stop tear propagation and considerable effort has been directed by those in this field to reach a

practical "compromise" between these opposing objectives, as applicant describes at p. 5, lines 10 - .p. 9, line 15. By means of the combination defined in the present claims of the main layer, the discontinuous first surface layer and the continuous second surface layer, applicant has been able to carry these efforts to a significantly higher level of success than before. And the Examiner saw for himself the extreme degree of tear resistance exhibited by the sample.

As was pointed out to the Examiner during the interview, the main claims, both product and process, have been simplified by focusing alone on the lamination strength of the "plies" of the cross-laminate (i. e. "film A and B" in the language of those claims) rather than the original dual or alternative objectives of lamination strength and/or optical appearance. Instead, the latter has been made the subject of dependent claims. Draft substitute main product and process claims were discussed with the Examiner and with slight changes in the former are presented herewith. To identify these changes: films A and B are now said in the main product claim to be separately coextruded and laminated together in sandwich relation, for more precise correspondence with the main process claim, and the orientation exhibited by the films is specified to be molecular orientation, as stated in the main process claim from the beginning.

The latter should make clear that the structural characteristic intended here is not a mere directional alignment of strands as the Examiner appears to have assumed in the rejection .

Also, the claims now employ the words "lamination" and "lamination strength" rather than than "bonding" and "bonding strength" and it should be noted that several different techniques for achieving such lamination are disclosed and claimed, namely, at least partly by heating (specifically called for in the EPO process claim 23 at line 16), by extrusion lamination

which involves introducing a separately extruded layer between the two films (see specification p. 16, last paragraph, and as between the "strand-free" regions of the adjacent film surfaces a behavior known as blocking, a phenomenon known in the paper art (and considered undesirable there) whereby sheets adhere together (as defined, e. g. at p. 311 of the text *ADHESIVE BONDING - Techniques and Applications* by Charles V Cagle, McGraw-Hill Book Company, New York, copyright 1968, a copy of which is enclosed. The "blocking effect" is described in the specification in the final paragraph of p. 17. In the case of "extrusion lamination", although the facing film surfaces are not in direct contact, as is true for lamination at least partly by heating, applicant advises that the lamination strength of the cross-laminate at the crossing points of the "strands" remains high.

As regards the optical aspect of the invention (now found in dependent product claim 97 and dependent process claim 111), the Examiner during the interview expressed difficulty in understanding how one might judge if the three-dimensional effect thereof was spaced internally "at least about 0.5 mm" as recited in the current claims, as would be necessary to evaluate a possibly infringing material. With a view to removing this problem, those claims have been changed to recited that the strands appear to be spaced internally a distance greater than the actual maximum thickness of the film. The problem was not whether a three-dimensional effect existed (as the Examiner indicated that he could readily perceive it) but how to define the same with reasonable clarity and it is believed that the new language will solve that problem.

Before considering specific issues raised in the action, applicant requests that **further consideration be given to the question of restriction between the product and method claims.** This was discussed during the interview and applicant appreciates the general policy of the Examiner's Art Unit, as explained by the Examiner, militating against examination of process claims by this Unit. However, in revising the new main claims, every effort has been

made to bring the product and method claims into precise correspondence. As a result, it is believed that basis for requiring restriction between these claims not longer exists. Instead, in applicant's attorney's view, the practice of the steps recited in the main process claim would necessarily result in the product defined in the main product claim and, conversely, the product as defined in the main product claim cannot be product by a method other than that set forth in the main process claim. It may be of interest for the Examiner to know that according to applicant, the product and process claims have now been accepted by the European Patent Office without restriction. In the light of the changed claim circumstances, a fresh look at this issue seems warranted and it respectfully solicited.

Turning now to the official action, the Examiner there criticizes the pending claims for their failure to separate each step or element by "line indentation" and , indeed, the MPEP as well as the Rules support this position. Applicant's attorney has not before encountered this criticism and is not at all certain as to its exact meaning or specific application to particular circumstances. However, in the spirit of cooperation, all of the claims are being re-formatted to what applicant's attorney assumes to be this pattern and it is presumed that the interpretation of the claims will not be influenced as a result. For this reason among others, all of the claims with the exception of the apparatus claims which are considered withdrawn due to restriction (but which are kept in the case pending a decision by applicant as to the filing of a divisional application directed thereto) are being presented as new schedule. This approach also makes possible the grouping together of all of the product claims, on the one hand, and all of the process claims, on the other, in numerical order, so as to avoid the need to skip back and forth in the list of claims.

For the Examiner's convenience, the following tabulation matches the old claims with the new. Where significant changes have been made in the new claims, they are designated (w/ amdts); where they are in applicant's attorney's best (but certainly not absolute) judgment

substantially unchanged (disregarding changes due to re-formatting and possible word substitutions), they are marked N/C. Claims that were canceled by prior amendments are marked "Previously canceled" while claims having no reasonable counterpart in the current claims are designated "NEW". Claims canceled by this amendment are marked "Cancel".

PRODUCT CLAIMS:

1	76 (w/ amdts)
2	77 (w/ amdts)
3	78 (w/ amdts)
4	79 (w/ amdts)
5	80 (w/ amdts)
6	81 (w/ amdts)
7	82 (w/ amdts)
8	Previously canceled
9	Previously canceled
10	83 (w/ amdts)
11	Previously canceled
12	84 (w/ amdts)
13	85 (w/ amdts)
14	86 (N/C)
15	87 (N/C)
16	Previously canceled
17	Previously canceled
18	Cancel
19	88 (w/ amdts)
20	89 (N/C)
21	90 (w. amdts)
22	91 (w/ amdts)
NEW	92
NEW	93
53	94 (W/ AMDTS)
54	Cancel
55	95 (N/C)
56	Cancel
57	96 (w/ amdts)
58	97 (w/ amdts)
59	98 (N/C)
60	99
61	100 (N/C)

PROCESS CLAIMS:

23	101 (w/ amdts)
24	Cancel
NEW	102
25	Previously canceled

26	103 (w/ amdts)
27	104 (w/ amdts)
28	Previously canceled
29	"
30	"
NEW	105
31	106 (w/ amdts)
32	Previously canceled
33	Previously canceled
NEW	107
35	108 (w/ amdts)
36	109 (w/ amdts)
NEW	110
62	111 (w/ amdts)
34	112 (N/C)
37	Apparatus (w/drawn)
38	Apparatus (w/drawn)
39 - 52	Previously canceled
63	113 (w/ amdts)
64	114 (N/C)
65	Cancel
66	"
67	"
68	"
69	"
70	"
71	115 (N/C)
72	116 (w/ amdts)
73	117 (N/C)
74	Apparatus (w/drawn)
75	"

In some of the instances above, the changes are concerned essentially only with quantitative limits. In several EPO claims, quantitative limits were expressed in terms of 3 alternatives, i. e. the broadest limits, the preferred limits, and finally the most preferred limits. In drafting the initial preliminary amendment, because such alternative limits are expressly prohibited and, consequently, applicant's attorney restricted such claims to the broadest limits. However, applicant instructed the undersigned to add in some cases claims to the most preferred amounts. Now, applicant has decided in some cases to change the broadest limits to the more practical preferred amounts. Examples (not necessarily a complete listing) are new claims 79, 81, 82, 90, and 108.

New claims 107 needs a special comment. The omission of a punctuation break between the extruding and orientating acts is deliberate because some orientation (melt orientation) can take place during the extrusion and hence, these acts can occur simultaneously teat least some extent.

Turning to specific points raised in the rejection, the relative terms "strongly bonded" and "at most weak" have been removed and replaced by the recitation that the "lamination strength [of the cross-laminate] is highest at the strand crossing points" which is believed to be a definite structural property that can be readily ascertained. However, the Examiner's objection apparently overlooked the presence of a positive standard for judging these terms in current claim 10 (now found in new claim 83), both as regards the magnitude of the "strong bond" (as measured by a specific technique i. e. "peel test") and the relationship of the "weak bond" thereto, e. g. "at the highest 75%" of the strong bond.

On the same point, the description of the "peel test" for measuring bonding or lamination strength has been rearranged in the pertinent claims so that minimum lamination strength at the crossing points of the strand arrays is said directed to be "at least 40 g/cm", as determined by the peel test, so that this structural characteristic is unmistakably set forth. The delineation in these claims of an actual technique for determining lamination strength actually makes the claims more definite in providing a basis for replicating the measurement in question as necessary for a direct comparison of different product runs.

The objectionable wording of former claim 57 (now appearing in essence in new claim 96) which recites the preferred relationship of "weak" to "strong" strength of "not more than 50%", has been removed with the description of the "peel test" repeated in full rather than being incorporated by reference.

Incidentally, the recitation of the "peel test" procedure cannot be deemed a "process

limitation" as asserted by Examiner later in the action. The lamination strength of the claimed product is a structural physical property; the test is simply a way of measuring the same and does not in any way alter the claimed product or the process of producing the same. More generally, virtually any physical property requires some way of measurement and if that way is not expressly set forth, it is incorporated by inference. For instance, a claim reciting a specific weight magnitude must infer that such value is measured by a scale or other weighing means while the recitation of a temperature value must infer measurement by a thermometer or the like but this certainly cannot mean that such measurement constitute process steps.

Continuing with rejection points, the Examiner's dismissal of a number of features as constituting "use limitations" is not at all understood since applicant's attorney cannot comprehend what is in fact the use envisioned (and it noted that the Examiner does not identify any "use" either directly or indirectly). A copy of MPEP 2173.05 (q) is annexed and the phraseology of the present claims bears not the slightest resemblance to the situations described in this manual section where this type of objection is warranted. The phrases in question here do not relate to any "use" in the usual sense of an adaptation for a specific purpose but to properties of the claimed product including the polymer material that is to be selected for a particular component which, broadly viewed, is in the nature of a structural property.

As regards the prior art rejections, the clarification of the main claims and the preceding discussion should have made evident the essential irrelevance of the references to applicant's actual invention. At a minimum, in the invention, there are two separate films each of which is a coextrudite of three layer, namely the main layer, the continuous second surface layer and the discontinuous first surface layer (to change the order to that in which they are arranged, the second layer being interposed between the main and first surface

layers), and these two films are laminated together with the first surface layers thereof facing one another. Such an arrangement is neither taught or suggested by the references.

In Britten, discrete pre-formed filaments or stands are embedded in layers of an adhesive and several such layers are combined by what is called "spot welding" with a "hot probe". These strands are not coextruded with any other layer. It is possible that applicant's use of the term "strand" has misled the Examiner when, in fact, they might better be viewed as streams or separate flows combined in the extrusion with continuous flows of the other layers. It has already been noted that the fact that applicant's several layers are coextruded together imparts a special character to the film whereby the several layers are integrated bodily into a unitary assembly that is quite evident from the sample left with the Examiner There is no evidence that any component of the reference has a molecular orientation imparted thereto and applicant's attorney even questions whether the "adhesive" embedment is capable of orientation given its apparent amorphous character. Among the adhesive materials identified in col 2, lines 49 - 54,. for the embedment layers are natural and synthetic rubbers which are obviously elastic and do not convey high tensile strength and it must be presumed that the other examples are al tleast generally similar. Even if the unbalanced strand arrangements are deemed a kind of orientation, there certain is no molecular orientation as now called for by all of applicant's claims.

On a more fundmental level, the reference objective is quite different from the invention in providing strand or filament reinforcement in a sheet material. Applicant's "strands" (or "streams") are not intended as reinforcement in the usual sense, as is made plain by the fact that their lengthwise directions are in crossing relation so that they extend an at angle to the length of the ultimate cross-laminate and occupy only finite length of the latter. That is, they lie obliquely of the cross-laminate from one side edge point to a downstream point on the opposite side edge. Nor are applicant's strands intended to provide significant

increase in tensile strength, it being the main layer that serves this function, as the claims state. Col 2, lines 42 -47 of the reference refers to the reinforcement strands or filaments, not the continuous adhesive layers.

As regards the pertinent of Britten to former claim 2 (77), there is no evidence that the action of the hot probes is precisely synchronized with the spacing both lengthwise and crosswise of the crossing points of the filaments as would be necessary to effect bonding of the filaments at these points. In fact, there is evidence to the contrary in that in the reference discussion of tear resistance of the reference materials, it is stated at col. 6, lines 9 - 13, that "...the individual strands lying transversely to the tear bunch together before the tear front and the further the tear porgresses the more transverse strands oppose the tear." For the strands to "bunch together", they must be able to shift or move within the adhesive embedment and this would not be possible if the strands were anchored together at their crossing points.

Much of the above comments apply equally to the Lappala patent. Thus, pre-formed discrete strands (which must be "multifilamentary strands - col. 2, line 12) arranged in grid fashion are interposed with a permanently tacky adhesive between two synthetic resin films. It is intended that the strands are able to shift within the adhesive so as to bunch together as is unmistakably depicted in Fig. 5 of the reference. Hence, the strands of the grid cannot be and are not) anchored at their crossing points. The reference does teach the use of molecularly orientated resin films but there is no suggestion of any coextrusion of such films with the filaments which would be impermissible since it would eliminate the embedment of the strands in the adhesive layer as is essential for any bunching effect.

Finally neither of the above main citations envision of lamination together of two separately coextruded multi-layer films (and especially cross-lamination of two films oriented

in crossing directions).

The other references are employed in the rejections only with regard to particular features of dependent claims and do not need detailed analysis. Johnson as its title denotes is concerned with a nonwoven fibrous products and thus utilizes pre-formed fibrous materials. Applicant's products are not fibrous. That some of these materials might be colored cannot conceivably teach the use of coloration to achieve the optical effect (perception) of increased strand depth as set forth in the claims relevant on this point. The association of corrugations in a surface of the film in this connection could not be derived from Lappala, for example where the corrugations are in the entire material and not just in a surface of one film and are caused by the pre-formed filaments themselves not a separate embossment of one surface film.

While Bonke suggests embossment of a "cling film" to reduce the area of contact of the film with an adjacent films, as when the film is dispensed in rolls. But it should be noted that it is the entire film that is embossed and not only a surface layer and, in any case, the possible relation of surface corrugations with a remarkable depth effect could never be derived from this patent.

Velazquez relates to a stretch film useful as wrapping film for food packages and the like. Such film is not molecularly oriented and it is difficult to comprehend how teachings of certain polymer compositions might be transposed to a totally different utility.

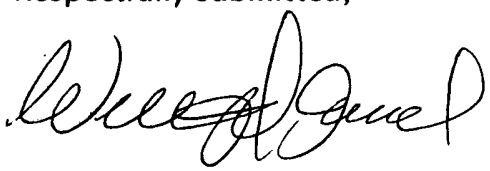
In Cederblad, an extruded netting is formed having different strands of the netting itself with different melting points so that some of the strands are adhesive and some are elastic and thereby achieve a combination of properties in the netting (see top of col. 2). This would not suggest different melting points for different layers of a multi-layer extrudite as in the invention.

In editing the new clear claim schedule, a number of the former claims are been deleted while some new claims have been added. By applicant's attorney's count from the list given earlier, **10 existing claims have been canceled** while **six new claims have been added.**

No changes have been made in the number of independent claims. Consequently, no additional claim fee is believed to be applicable; however, if the tally is incorrect, authorization is hereby given to charge any additional fee to Deposit Account #04-0070 of the undersigned attorney.

For the many reasons set forth above and in view of the amended claims now presented, reconsideration of the objections and rejections is requested.

Respectfully submitted,



WILLIAM J. DANIEL, REG.NO. 16,585

ATTORNEY OF RECORD

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(Comm'r Pat. 1914). The *Ex parte Whitelaw* doctrine is restricted to cases where the claims are unduly multiplied or are substantial duplicates. *Ex parte Kochan*, 131 USPQ 204, 206 (Bd. App. 1961).

2173.05(o) Double Inclusion

There is no *per se* rule that "double inclusion" is improper in a claim. *In re Kelly*, 305 F.2d 909, 916, 134 USPQ 397, 402 (CCPA 1962) ("Automatic reliance upon a 'rule against double inclusion' will lead to as many unreasonable interpretations as will automatic reliance upon a 'rule allowing double inclusion'. The governing consideration is not *double inclusion*, but rather is what is a reasonable construction of the language of the claims."). Older cases, such as *Ex parte White*, 759 O.G. 783 (Bd. App. 1958) and *Ex parte Clark*, 174 USPQ 40 (Bd. App. 1971) should be applied with care, according to the facts of each case.

The facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim gives rise to indefiniteness in that claim. The mere fact that a compound may be embraced by more than one member of a Markush group recited in the claim does not lead to any uncertainty as to the scope of that claim for either examination or infringement purposes. On the other hand, where a claim directed to a device can be read to include the same element twice, the claim may be indefinite. *Ex parte Kristensen*, 10 USPQ2d 1701 (Bd. Pat. App. & Inter. 1989).

2173.05(p) Claim Directed to Product-By-Process or Product and Process

There are many situations where claims are permissively drafted to include a reference to more than one statutory class of invention.

I. PRODUCT-BY-PROCESS

A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper. *In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973); *In re Pilkington*, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969); *In re Steppan*, 394 F.2d 1013, 156 USPQ 143 (CCPA 1967). A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process.

An applicant may present claims of varying scope even if it is necessary to describe the claimed product in product-by-process terms. *Ex parte Pantzer*, 176 USPQ 141 (Bd. App. 1972).

II. PRODUCT AND PROCESS IN THE SAME CLAIM

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

2173.05(q) "Use" Claims

Attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, second paragraph. For example, a claim which read: "A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon." was held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).

Other decisions suggest that a more appropriate basis for this type of rejection is 35 U.S.C. 101. In *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967), the Board held the following claim to be an improper definition of a process: "The use of a high carbon austenitic iron alloy having a proportion of free carbon as a vehicle brake part subject to stress by sliding friction." In *Clinical Products Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966), the district court held the following claim was definite, but that it

was not a proper process claim under 35 U.S.C. 101: "The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfonic acid."

Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim.

A "USE" CLAIM SHOULD BE REJECTED UNDER ALTERNATIVE GROUNDS BASED ON 35 U.S.C 101 AND 112

In view of the split of authority as discussed above, the most appropriate course of action would be to reject a "use" claim under alternative grounds based on 35 U.S.C. 101 and 112.

BOARD HELD STEP OF "UTILIZING" WAS NOT INDEFINITE

It is often difficult to draw a fine line between what is permissible, and what is objectionable from the perspective of whether a claim is definite. In the case of *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992), the Board held that a claim which clearly recited the step of "utilizing" was not indefinite under 35 U.S.C. 112, second paragraph. (Claim was to "A method for unloading nonpacked, nonbridging and packed, bridging flowable particle catalyst and bead material from the opened end of a reactor tube which comprises utilizing the nozzle of claim 7.").

2173.05(r) Omnibus Claim

Some applications are filed with an omnibus claim which reads as follows: A device substantially as shown and described. This claim should be rejected under 35 U.S.C. 112, second paragraph, because it is indefinite in that it fails to point out what is included or excluded by the claim language. See *Ex parte Fressola*, 27 USPQ2d 1608 (Bd. Pat. App. & Inter. 1993), for a discussion of the history of omnibus claims and an explanation of why omnibus claims do not comply with the requirements of 35 U.S.C. 112, second paragraph.

Such a claim can be rejected using Form Paragraph 7.35. See MPEP § 706.03(d).

For cancellation of such a claim by examiner's amendment, see MPEP § 1302.04(b).

2173.05(s) Reference to Figures or Tables

Where possible, claims are to be complete in themselves. Incorporation by reference to a specific figure or table "is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim. Incorporation by reference is a necessity doctrine, not for applicant's convenience." *Ex parte Fressola*, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) (citations omitted).

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. See MPEP § 608.01(m).

2173.05(t) Chemical Formula

Claims to chemical compounds and compositions containing chemical compounds often use formulas that depict the chemical structure of the compound. These structures should not be considered indefinite nor speculative in the absence of evidence that the assigned formula is in error. The absence of corroborating spectroscopic or other data cannot be the basis for finding the structure indefinite. See *Ex parte Morton*, 134 USPQ 407 (Bd. App. 1961), and *Ex parte Sobin*, 139 USPQ 528 (Bd. App. 1962).

A claim to a chemical compound is not indefinite merely because a structure is not presented or because a partial structure is presented. For example, the claim language at issue in *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) referred to a chemical compound as a "polypeptide of at least 24 amino acids having the following sequence." A rejection under 35 U.S.C. 112, second paragraph, for failure to identify the entire structure was reversed and the court held: "While the absence of such a limitation obviously broadens the claim and raises questions of sufficiency of disclosure, it does not render the claim indefinite." Chemical compounds may be claimed by